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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/057,660

Filing Date: January 25, 2002

Appellant(s): BORTLIK ET AL.

Robert M. Barrett
For Appellants

EXAMINER'S ANSWER

This is in response to the appeal brief filed May 16, 2007 appealing from the Office action mailed August 3, 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellants' statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellants' statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5643623 A

SCHMITZ et al.

07-1997

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 65 – 76, 78 – 82 and 86 – 93 are rejected under 35 U.S.C. 102(b) as being anticipated by Schmitz et al. (US 5643623).

Appellants claim a composition comprising at least one lipophilic bioactive compound (LBC) and a whey protein, wherein the protein is in an amount effective to increase the bioavailability of the bioactive compound. The LBC is obtained from plants selected from tomatoes, soya, green tea, green coffee bean, spices, grapes, cocoa, ginger or cereals; microorganisms of any bacterium, yeasts, or animal products selected from liver extract of milk fractions. The LBC is selected from carotenoids, polyphenols, lipophilic vitamins, flavonoids, isoflavones, curcuminoid, ceramide, proanthocyanidin, terpenoid, sterol, phytosterol, sterol ester, tocotrienol, squalene, retinoids, or mixtures thereof. Specifically, the LBC is a tomato extract, soybean extract or a mixture thereof; the composition is a powder, gel or liquid; and the composition further comprises at least one of an emulsifier, stabilizer, or other additive. The LBC is 0.05 – 50% of the composition, the whey protein is 5 – 90%; or the ratio of whey protein

to LBC is 1:1 – 500:1. The composition is incorporated into an oral composition selected from a food stuff, food supplement, or pharmaceutical preparation wherein the food stuff is a yogurt, drink, chocolate containing product, ice cream, cereal, coffee or animal food; and the supplement further comprises at least one of a sweetener, stabilizer, flavoring or colorant; and is a sugar coated tablet, pill, gelatin capsule, syrup, gel or cream. Appellants additionally claim a composition with 0.001 – 100% or 10 – 50% of the claimed composition.

Schmitz teaches a human or animal food composition comprising 20 – 40% whey, 0.1 – 1% carotenoids, and 1.5 – 3.5% vitamin E and C (example 6). The antioxidant mixture may contain lycopene (lipophilic bioactive compound, carotenoid from tomato), vitamin C and E (abstract). Schmitz teaches the composition may be a solid, semi solid, liquid or gel (col.4 line 9-17). Specifically, Schmitz teaches a first component comprising 10 – 20% whey protein, 0.1 – 1% carotenoids, and 1.5 – 3.5% vitamin E and C (example 6), wherein the first component further comprises a lipid carrier, herbal extract or mineral supplement (or additives) (col.5 line 23-28) and corn syrup (a sweetener) (example 6). Schmitz further teaches that the first component is blended such that the ingredients are dispersed and mixed together (examples) as well as blended into a homogeneous mixture (example 5) and that the first component is present in food products at 5 – 60% (col.5 line 55-60).

Although Schmitz does not teach the source from which the LBC were obtained, the patentability of a product does not depend on its method of production. If the claimed product is the same or obvious from a product in the prior art (i.e. the product disclosed in the cited reference), the claim is unpatentable even though the reference product was made by a different process. When the prior art discloses a product which reasonably appears to be identical with or

slightly different than the claimed product-by-process, rejections under 35 U.S.C 102 and/or 35 U.S.C 103 are proper. (MPEP 2113)

In addition, although Schmitz does not teach the claimed function of the whey, the discovery of a previously unappreciated property of a prior art composition does not render the old composition patentably new. Thus the claiming of a new use, function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable (MPEP 2112).

Therefore, the reference anticipates the claimed subject matter.

(10) Response to Argument

Appellants argue that Schmitz does not teach each of the claimed elements. Specifically in that the reference fails to teach sufficient amounts of whey to increase bioavailability of LBC; a homogeneous mixture of LBC and whey; and that the composition does not enhance bioavailability of LBC. Appellants further argue that the invention is drawn to a uniform, homogeneous mixture of whey and LBC without encapsulation or a core; and that the composition cannot be encapsulated. In addition, appellants state that one in the art would know that the invention is drawn to a homogeneous mixture, not a heterogeneous mixtures as disclosed by Schmitz; and that a mixture is defined by blending, thus one in the art would know the claimed "mixture" is homogeneous, not heterogeneous. Finally, appellants argue that the composition of Schmitz is not inherently the same as claimed because the claimed activity is not disclosed, is not necessarily present, or recognized by the prior art. Appellants support the

arguments with an affidavit filed on November 22, 2006, which states the same as argued by appellants.

However, these arguments fail to persuade because as stated above, Schmitz clearly teaches a combination of whey and LBC homogenized together in the amounts as claimed (examples 5,6). While the reference does not recognize the claimed function, Schmitz teaches the claimed ingredients in the claimed amounts. Thus the composition of Schmitz must inherently perform the functions as disclosed by appellants. Otherwise appellants' invention could not function as claimed. It is noted that appellants admit that the reference teaches a composition with LBC and whey used as a carrier (p.13 of Appeal Brief), even though the intended activity is not disclosed.

Regarding appellants' arguments that the invention is a uniform, homogeneous mixture without encapsulation, it is noted that the instant claims do not require the mixture to be homogenized nor do they exclude encapsulation or core containing compositions. Thus, the argument is not commensurate in scope with the claims. Even if the claims were limited to such a homogeneous composition, it is noted that examples 5 and 6 clearly teach a homogeneous blend of whey and LBC as the first component. Furthermore regarding appellants' argument that the composition cannot be encapsulated, it is noted that the claims are not limited to the tomato oleoresin that exhibits the characteristic argued by appellants. Thus, the argument is not commensurate in scope with the claimed invention.

Regarding appellants' comments that one in the art would know that the claimed composition is homogeneous since it is a mixture, or blended, it is maintained that the claims are not limited to a homogeneous mixture. Further, as defined by "On-Line Medical Dictionary",

the term mixture is not equivalent to the term homogeneous. Specifically, a mixture is defined as a variable composition containing 2 or more substances; while homogeneous is defined as consisting of similar elements with a uniform quality (see attachment). Thus, these terms are not considered interchangeable. It is noted that the specification fails to define the term "mixture", thus the term is presumed to take on the ordinary and customary meanings attributed to them by those of ordinary skill in the art (MPEP 2111.01 III).

Regarding appellants' argument that the composition of the prior art does not inherently exhibit the claimed characteristics, it is reiterated that Schmitz clearly teaches the claimed amounts of whey and LBC homogenized together in a single composition (example 6, first component). Thus the composition of Schmitz must necessarily perform the functions as disclosed by appellants. Otherwise appellants' invention could not function as claimed. Furthermore, it is reiterated that "[T]he discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art's functioning, does not render the old composition patentably new to the discoverer." Thus the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable." (MPEP 2112) In addition, "There is no requirement that a person of ordinary skill in the art would have recognized the inherent disclosure at the time of invention" (MPEP 2112).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Ruth A. Davis

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